REMARKS

Claims 1-19 are pending. Claims 13 and 14 have been amended. No claims have been canceled, and no new claims have been added. Therefore, claims 1-19 are pending. Applicant respectfully requests reconsideration of the claims in view of the above amendments and the following remarks.

The Office Action rejected claims 1-18 under 35 U.S.C. §103 "as being unpatentable over" US Patent 5,960,406 to Rasansky et al. (herein "Rasansky") "further in view of" US Patent 6,016,478 to Zhang et al. (herein "Zhang"). Applicants note that the Office Action did not address claim 19, as added in the Applicants' response filed January 5, 2009.

As a preliminary matter, Applicants note that both Rasansky and Zhang relate to a form of scheduling an event in a computer network, in which one person (an invitor) sends an invitation to another person (an invitee). The invitation contains information about the event. The invitee can then accept or decline the invitation. If the invitee accepts, Zhang teaches putting the event – as defined by the information sent by the invitor in the invitation – in the invitee's electronic calendar.

The presently claimed invention discloses a new model; one that does not require an invitor to send an invitation directly to an invitee, and that does not require the invitee to receive and/or respond to the invitor to accept the invitation. Rather, in the presently claimed invention, a person who finds an event posted on a web page can add the event to his or her calendar by simply taking action on the web page itself (e.g., clicking on a link in the web page).

As a result, the structure and mechanics of the old paradigm do not teach the elements of the present claims, as will be discussed more fully below.

I. Rasansky and Zhang Do Not Render Claim 10 Obvious Because Rasansky And Zhang Fail To Teach The First Element Of Claim 10

This Amendment will address claim 10 first, because the Office Action addressed claim 10 first.

Claim 10 requires:

> a first link, inserted in a web page associated with the event creator
> and including the event, that when selected by the invitee creates a
> schedule request including at least the predetermined time for the event
> and an identifier for the event creator, the schedule request directing the
> event to the invitee's calendar;

Applicants note that this first element comprises a link. However, the link is not just any link in a web page. This link has certain characteristics – specifically, that "when selected by the invitee creates a schedule request including at least the predetermined time for the event and an identifier for the event creator, the schedule request directing the event to the invitee's calendar."

The Office Action has not identified a reference that teaches a link with such characteristics. In fact, the Office Action acknowledged that Rasansky fails to disclose "a first link, inserted in a web page associated with the event creator and including the event." In addition, the Office Action made no allegation that Zhang teaches such an element. Therefore, neither Rasansky nor Zhang teach the first element of claim 10. Accordingly, for at least this reason, Applicants respectfully submit that claim 10 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

II. Rasansky and Zhang Cannot Be Combined Because Parsing A Single Element Into Two Parts Is Impermissible Hindsight

In its analysis, the Office Action parsed the first element of claim 10 into two parts:

(i) "a first link, inserted in a web page associated with the event creator and including the event," and

(ii) "that when selected by the invitee creates a schedule request including at least the predetermined time for the event and an identifier for the event creator, the schedule request directing the event to the invitee's calendar. . . ."

The Office Action then proceeded to address the two parts separately, citing Zhang for the first part of the first element, and citing Rasansky for the second part of the first element.

Applicants respectfully submit that parsing a single element in this way is not proper analysis under the patent statutes, because it involves impermissible hindsight. As stated in Section 2141.01 of the Manual of Patent Examining Procedure (Revision 7 of the Eighth Edition, herein, "M.P.E.P.") :

> It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the **art. >...<" *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

As stated by the Court of Appeals for the Federal Circuit:

> Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

By breaking the first element of claim 10 into two parts, the Office Action has failed to "forget" what was taught by the present application and failed to "cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art."

Instead the Office Action has "selectively culled" components from the prior art "to fit the parameters of the patented invention. . . .", and thereby engaged in impermissible hindsight. Specifically, the Office Action has parsed the first element into two parts, and then used those parts as a recipe to combine components of prior art.

It appears that the Office Action has taken the previously-known Zhang reference as a starting point for parsing the first element into two parts (Zhang was cited in the Notice of References in the Office Action dated October 3, 2006). The Office Action defined the first part by what was allegedly taught by Zhang, and then used the remaining limitations as a recipe to find Rasansky.

Therefore, Applicants respectfully submit that the Office Action has failed to properly find the first element in the prior art, at least because the application of the combination of Zhang and Rasansky involves impermissible hindsight. Accordingly, for at least this reason, Applicants respectfully submit that claim 10 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

III. Rasansky and Zhang Do Not Render Claim 10 Obvious Because Rasansky And Zhang Fail To Teach The Constituent Parts Of Claim 10

Although Applicants believe that parsing a single element into multiple parts is inappropriate, Applicants will address the parts in order to show that Rasansky and Zhang do not teach or suggest the constituent parts of claim 10.

A. <u>Zhang Does Not Teach Or Suggest Link In A Web Page</u>

The first part of the first element of claim 10, as parsed by the Office Action, requires "a first link, inserted in a web page associated with the event creator and including the event...."

For this fractional part of the element, the Office Action cites to Zhang's disclosure of an "Accept button" at column 13, lines 22-25 (the text below includes text on column 13, line 26, for the sake of presenting a complete sentence):

> Accept button 631 lets the user enter a short reply message (via Reply dialog 635 in FIG. 6B), and then sends the acceptance to the initiator confirming that the user will attend. The event is automatically added to the user's calendar.

The cited text does not mention a web page, or a link in a web page. Therefore, the cited text from Zhang fails to anticipate the link in a web page as required by claim 10.

To the contrary, a closer reading of Zhang shows that the cited text relates not to a web page, but to a button within an invitation, such as an email invitation.

Specifically, the cited text is part of a section of Zhang entitled "B. Peer-to-Peer Scheduling Interface" which Zhang describes as follows at column 10, lines 44-52 (underlining added for emphasis):

> The Group Scheduling module 127 uses <u>electronic messaging</u> to communicate with others to schedule events and book resources. Because it supports numerous <u>e-mail platforms</u>, including the Internet, the module can provide group scheduling with users anywhere in the world. The system automatically invites the participants to an event the user schedules, and collects their replies for accepting or declining the invitation or for requesting that the user reschedule it.

Thus, an invitee in Zhang's system receives an invitation via "electronic messaging" (such as email), and may accept or decline the invitation.

Zhang's system is illustrated by Zhang's Fig. 6A and Fig. 6B (the Office Action cited to Fig. 6B):

FIG. 6A

FIG. 6B
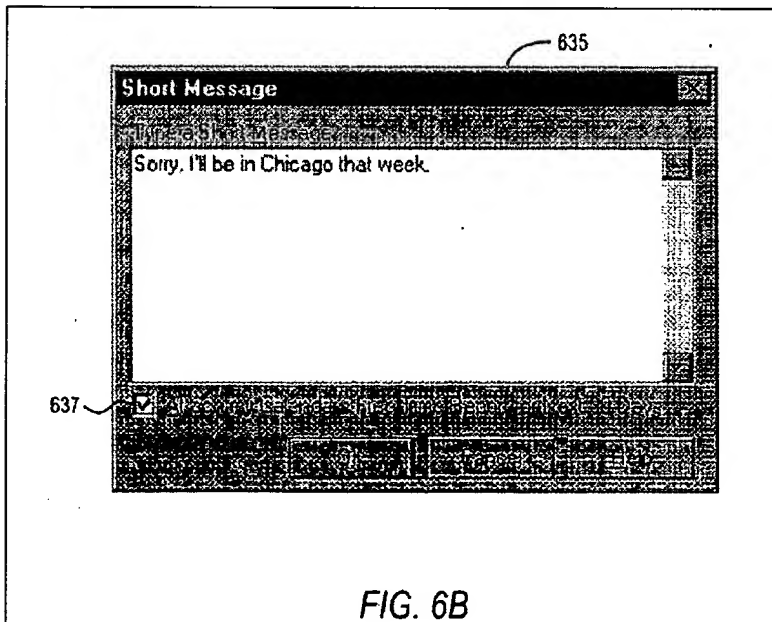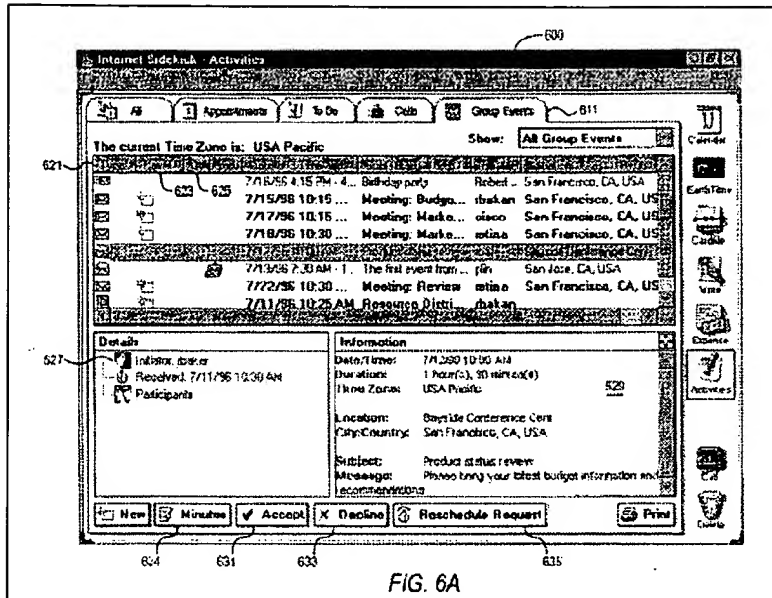
Thus, Zhang's "Accept" button is not in a web page, but instead, is in an invitation in an email, or other electronic messaging system, as shown in the figures above, which do not show a web page. As such, neither Zhang's text nor the figures teaches or suggests a link in a web page.

Because the Office Action cited Zhang for the link in a web page, and because Zhang does not teach such a link, Zhang cannot be successfully combined with Rasansky to teach the first element of claim 10. As such, Rasansky and Zhang do not anticipate claim 10, or render it obvious. Accordingly, for at least this reason, Applicants respectfully submit that claim 10 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

B. Rasansky Does Not Teach Or Suggest Selection by Invitee, Or Events That Flow From Such A Selection

The second fractional part of the first element of claim 10, as parsed in the Office Action, requires that certain activities occur as a result of a something being selected by the invitee - specifically:

> that when selected by the invitee creates a schedule request including at least the predetermined time for the event and an identifier for the event creator, the schedule request directing the event to the invitee's calendar;

Applicants note that the awkward parsing of this element in the Office Action makes this a sentence fragment that lacks an object – i.e., it does not tell us what is being selected by the invitee. Clearly, however, it does require that something be selected by the invitee, and that certain events result from such a selection.

The Office Action cites Rasansky for this limitation (column 5, lines 9-27, copied below). However, that analysis fails for at least two reasons.

First, the cited text of Rasansky does not teach the link to be selected. Consequently, Rasansky cannot and does not teach the selection of such a link.

Second, because Rasansky does not teach such a selection, Rasansky does not teach the recited activities that occur as a result of such a selection.

Further, the passage does not relate to adding an event to a calendar. At best, the cited text describes a system that allows users of a proprietary system ("Appointnet") to communicate with each other (i.e., "selected individuals or groups of individuals") by sending messages using "the World Wide Web as a transport medium for connecting end users...."

Because Rasansky was cited for teaching the selection of a link by an invitee, and that certain events flow from such a selection, and because Rasansky does not teach such selection and that certain events flow from such a selection, Rasansky and Zhang cannot be successfully combined to teach the first element of claim 10. Accordingly, for at least this reason, Applicants respectfully submit that claim 10 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

C. Rasansky Does Not Teach Or Suggest Creating A Schedule Request

The first element of claim 10 also requires the creation of:

> a schedule request including at least the predetermined time for the event and an identifier for the event creator....

The Office Action again cites Rasansky at column 5, lines 9-27 for this part of the claim:

> The Appointnet system of the present invention provides an efficient mechanism through which an individual or groups of individuals can set appointments in time and place; organize events; send announcements; and post reminders in such a way that information is available to selected individuals or groups of individuals. The determination of the scope of the recipient list is at the discretion of the originator of the message. Appointnet preferably uses the World Wide Web as a transport medium for connecting end users with client devices 20 who wish to invite other end users that in turn receive the appointments, events, and other messages. End users in their

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roles as senders or recipients of messages sent via the Appointnet system use a Web Browser 100 to connect to the Web subsystem 70. By working with a simple set of forms and calendars expressed in standard HTML and visible in the client device, end users access and manipulate the data stored in the Database Subsystem 110 to create messages that are then visible to other end users of the Appointnet system."

However, a review of the cited text (copied above) reveals that it does not teach or suggest anything like a "schedule request" created in response to an action by the invitee.

Furthermore, to the extent that anyone in Rasansky creates, or causes to be created, a message including a time for an event and an identifier for the event creator, it is not the invitee (as in claim 10). Rather, it is Rasansky's event creator (sometimes referred to as an "invitor"; i.e., "end users . . . who wish to invite other end users"). For example, the cited text teaches that the "Appointnet" system operates to allow "end users with client devices 20 who wish to invite other end users" (e.g., event creators, or invitors, or "initiators") to connect with those "other end users that in turn receive the appointments, events, and other messages" (e.g., invitees).

Therefore, in Rasansky the event creator or invitor creates the "appointments" and "events." Accordingly, in Rasansky the "appointments" and "events" are not created by the invitee at all (and in any case are not created by the invitee by some action taken by the invitee on a web page).

Because Rasansky was cited for teaching a schedule request, and because Rasansky does not teach a schedule request, Rasansky and Zhang cannot be successfully combined to teach the first element of claim 10. Accordingly, for at least this reason, Applicants respectfully submit that claim 10 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

D. Rasansky Does Not Teach Or Suggest An Event Record

Claim 10 also requires a server to store the event in "an event record that includes a second link to the invitee's calendar...."

For "event record," the Office Action cites to Rasansky's column 17, lines 28-49:

> FIG. 17A through 17F illustrate the sending of an invitation to an end user from an existing end user using the Appointnet system of FIG. 15. The "Invite" function is used to request an appointment with someone 1550. The calendar's mode (monthly/weekly/daily) is determined by the current state of the calendar in view. In the monthly mode of this embodiment, the inviting user can choose up to 10 time slots for any time sensitive event with the pull-down time lists 1555 found in each day's cell. (While inviting 10 times is currently available with the system, any number of time slots for time sensitive events is possible.) Otherwise the user can use the pull-down menu 1560 to suggest up to 10 times and dates that are free for the meeting, and do not appear on the displayed calendar. The invitee's Email address is filled in 1570 or can be selected from a list of addressed that were saved earlier 1580. The subject 1590 for the invitation may be filled in as well as the length of time for the particular invitation 1600. Upon sending the invitation 1610, a view record is created both for the invitee and invitor. Email may also be sent to the invitee at this time. The Email alerts the invitee about the invitation and lures the user to the site where the user can see and gain access to their calendar.

The Office Action did not provide any analysis of the foregoing text to identify how it allegedly teaches an event record. However, Applicants note that this paragraph contains eleven sentences. The first eight sentences relate to the creation of an invitation by an "inviting user." Therefore, none of these sentences relate to creating anything like an "event record" created in response to an action by an invitee. In addition, none of the first eight sentences teach or suggest anything that "includes a second link to the invitee's calendar."

The tenth and eleventh sentences relate to sending email to the invitee. Similarly, neither of these sentences relate to creating anything like an "event record" in response to an action by an invitee. In addition, neither of the last two sentences teach or suggest anything that "includes a second link to the invitee's calendar."

Applicants note, from only other sentence in this passage (i.e., the ninth sentence), the foregoing passage, "a View record is created both for the invitee and invitor." However, Rasansky's "View record" cannot be an "event record."

As Rasansky explains (column 13, lines 23-32):

> Each end user who can see an Event in his calendar can do so because he has a View record that points to a Group record. Those View records are created by the Appointnet system when the creating end user sends event messages to others on the system. When an invitation is sent a Group record is created, then a View record is created so the sender can see the Group record, and then another View record is created to [sic] the recipient can see the Group record.

As such, a "View record" cannot be a "second link to the invitee's calendar" as required by claim 10, for at least two reasons. First, a "View record" does not point to the invitee's calendar. Instead, it points from the invitee to a "Group record" (i.e., "and then another View record is created to [sic] the recipient can see the Group record.")

Second, a "View record" is created as a result of action by the invitor (i.e., "When an invitation is sent...."), not as a result of action by the invitee as required by claim 10.

Because Rasansky was cited for teaching an event record, and because Rasansky does not teach an event record, Rasansky and Zhang cannot be successfully combined to teach the first element of claim 10. As such, Rasansky and Zhang do not anticipate claim 10, or render it obvious. Accordingly, for at least this reason, Applicants respectfully submit that claim 10 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

IV. <u>Rasansky and Zhang Do Not Render Claim 10 Obvious Because Rasansky and Zhang Cannot Be Properly Combined Under 35 U.S.C. §103</u>

Section 2143.01 of the M.P.E.P. teaches that references cannot be combined to support a rejection for obviousness under 35 U.S.C. §103 if, among other things, (i) the proposed combination would change the principle of operation of a reference, or (ii) the proposed combination would render the teachings of a references unsatisfactory for their intended purposes.

Applicants respectfully submit that Zhang and Rasansky cannot be properly combined support a case of obviousness under 35 U.S.C. §103, for at least these two reasons.

These issues arise from the fact that the operation of Zhang and the operation of Rasansky require actions by different people. Specifically, the Office Action cited Zhang for its "Accept button." In Zhang, the Accept button is operated <u>by the invitee</u>. The Office Action cited Rasansky as allegedly teaching the "schedule request," among other things. As explained above, Rasansky's invitation is created <u>by the invitor</u>, not the invitee.

To combine Zhang and Rasansky to suggest all of the actions of the single invitee in claim 10 (e.g., selecting a link and thereby causing certain actions to occur) would mean either (a) attributing the action of Rasansky's invitor to Zhang's invitee, or (b) attributing the action of Zhang's invitee to Rasansky's invitor. Such a combination of Zhang and Rasansky would change the principle of operation of each reference, and would also render both teachings unsatisfactory for their respective intended purposes.

A. <u>Changing Principles of Operation</u>

The combination of Zhang and Rasansky would change the principle of operation of each reference.

Such a combination would change the principle of operation of Zhang, because the combination would require action by the invitor, when the cited portions of Zhang involve action by the invitee. Likewise, such combination would change the principle of operation of Rasansky, because the combination requires action by the invitee, where the

cited portions of Rasansky involve action by the invitor. Thus, the proposed combination of Zhang and Rasansky change the principle of operation of each reference by changing the actor responsible for each action. Such a combination fails to support a case of obviousness [M.P.E.P. § 2143.01 VI: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)"].

B. <u>Rendering The Prior Art Invention Being Modified Unsatisfactory For Its Intended Purpose</u>

Combining the teachings of Zhang and Rasansky would also render both teachings unsatisfactory for their intended purposes.

The purpose of the cited portion of Zhang is to allow an invitee to respond to an invitation. However, the purpose of the cited portions of Rasansky us to allow people to communicate with each other, as initiated by an invitor.

To combine Zhang and Rasansky to suggest all of the actions of the single invitee in claim 10 (e.g., selecting a link and thereby causing certain actions to occur) would require either (x) Rasansky's invitor to respond to his or her own invitation [i.e., substituting Rasansky's invitor for Zhang's invitee], or (y) Zhang's invitee to create and send his or her own invitation [i.e., substituting Zhang's invitee for Rasansky's invitor]. Clearly neither would be workable systems, and as such, unsatisfactory for their respective intended purposes.

Therefore, each reference – as modified by the other – would be rendered unsatisfactory for its intended purpose. Such a combination fails to support a case of obviousness [M.P.E.P. § 2143.01 V: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)"].

For at least the reasons set forth above, claim 10 is not anticipated or made obvious by Rasansky, Zhang, or the combination of Rasansky and Zhang. Therefore,

Applicants respectfully submit that claim 10 and its dependent claims are allowable over, Rasansky, Zhang, and the combination of Rasansky and Zhang.

V. Rasansky And Zhang Do Not Render Claim 1 Obvious Because Rasansky And Zhang Fail To Teach Several Elements Of Claim 1

The Office Action rejected claim 1 on the same bases as applied to claim 10. Applicants respectfully submit that claim 1 is allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang for at least reasons similar to those explained with respect to claim 10, above.

Claim 1 requires activity resulting from action by an invitee on a web page, which (as explained above) is not anticipated by Rasansky, Zhang, or the combination of Rasansky and Zhang.

Claim 1 also requires a schedule request, and an event record that includes a link to the calendar of the invitee, neither of which (as explained above) are anticipated by Rasansky, Zhang, or the combination of Rasansky and Zhang. As such, Rasansky and Zhang do not anticipate claim 10, or render it obvious. Accordingly, for at least this reason, Applicants respectfully submit that claim 1 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

VI. Rasansky And Zhang Do Not Render Claim 14 Obvious Because Rasansky And Zhang Fail To Teach Several Elements Of Claim 14

The Office Action rejected claim 14 on the same bases as applied to claim 10. Applicants respectfully submit that claim 14 is allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang for at least reasons similar to those explained with respect to claim 10, above.

Claim 14 requires code for engaging in certain activity resulting from action by an invitee on a web page, which (as explained above) is not anticipated by Rasansky, Zhang, or the combination of Rasansky and Zhang.

Claim 14 also requires program code for processing a schedule request and creating an event record, neither of which (as explained above) are anticipated or rendered obvious by Rasansky, Zhang, or the combination of Rasansky and Zhang.

As such, claim 14, and its dependent claims, are not anticipated by Rasansky, Zhang, or the combination of Rasansky and Zhang. Accordingly, for at least this reason, Applicants respectfully submit that claim 14 and its dependent claims are allowable over Rasansky, Zhang, and the combination of Rasansky and Zhang.

VII. Amendment To Claims 13 and 14

Applicants have amended claim 13 to specify that the web page is a page on the World Wide Web.

Applicants have amended claim 14 to add a comma in the first element, after the word "event" and before the clause "at a server...."

VIII. The Office Action Has Not Rejected Claim 19

As noted above, Applicants added a new claim, claim 19, the Applicants' response filed January 5, 2009. The Office Action did not address, and therefore has not rejected, claim 19. As such, Applicants respectfully request allowance of claim 19 for at least this reason.

All pending claims are believed to be in a form suitable for allowance. Therefore, the application is believed to be in a condition for allowance. The Applicant respectfully requests early allowance of the application. The Applicant requests that the Examiner contact the undersigned, Thomas J. Tuytschaevers, if it will assist further examination of this application.

Applicants petition for a one (1) month extension of time. In the event that a further extension is needed, this conditional petition of extension is hereby submitted. Applicant requests that deposit account number 19-4972 be charged for any fees that may be required for the timely consideration of this application.

Date: June 11, 2009

Respectfully submitted,

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